

-2-

REMARKS

The Examiner has rejected Claims 24, 25, 28, 34, 35, 38, 32, 33 and 42-44 under 35 U.S.C. 102(e) as being anticipated by Engel et al. (U.S. PGPub. 2002/0198969). The Examiner has rejected Claims 1, 9, 10-12 and 20-23 under 35 U.S.C. 103(a) as being unpatentable over Engel and Poger et al. (U.S. Patent No. 6,772,420). Applicant respectfully disagrees with such rejection for the reasons argued below.

Moreover, such rejection is moot since applicant's invention was completed in the United States at a date prior to June 25, 2001, the effective date of United States Patent Publication No. 2002/0198969 that was cited by the Examiner. A declaration and exhibit evidencing such are submitted herewith.

In particular, declarations signed by inventors are submitted herewith establishing completion of the invention in this application in the United States at a date prior to June 25, 2001. Evidencing such completion is an e-mail and a confidential disclosure document generated before the filing of the present patent application showing the conception of providing web browser-based secure remote network appliance configuration in a distributed computing environment at least as early as April 3, 2001.

Furthermore, statements by inventors are provided which state that, at a date prior to June 25, 2001, the invention in the above patent application was conceived to include one or more network appliances interconnected within a bounded network domain defined by a common network address space; and a configuration client comprising an applet executing within a Web browser and configuring the network appliances, comprising: a status module broadcasting a query message to the network appliances and processing a response message containing network settings, including a physical network address, received by the applet from at least one such network appliance responsive to the query message; and a configuration module generating and sending a configuration packet using the physical network address for each at least one such network appliance sending a response message and requiring configuration.

-3-

Moreover, the invention in the above patent application was conceived to include at least one network appliance sending a response message containing network settings responsive to a query message broadcast over a specified network domain within which the at least one network appliance operates; a configuration client generating a configuration package for the at least one network appliance and containing centrally managed network settings customized for the at least one network appliance; and a bootstrap module on the at least one network appliance installing the configuration package as part of an initialization bootstrap operation, as well as other claimed features.

In view of such declaration and supporting evidence, the foregoing rejection is deemed to have been overcome. An allowance is respectfully requested. In addition to such declaration and supporting evidence of prior invention, applicant respectfully asserts that the Engel reference does not even teach all of applicant's claim language.

For example, the Examiner has relied on the following excerpt from Engel to make a prior art showing of applicant's claimed "sending a configuration packet using the physical network address for each at least one such network appliance sending a response message and requiring configuration" (see this or similar, but not identical, language in at least some of the independent claims).

"At step 104, the remote configuration applet 20 obtains the network configuration parameters 64 from the configuration server 10. For example, the configuration server 10 may send a message 62 to the remote configuration applet 20 via the communication network 30 using Internet protocols. The message 62 carries the network configuration parameters 64 along with a command that instructs the remote configuration applet 20 to relay the network configuration parameters 64 onto the network device 40." ([0031])

Applicant respectfully asserts that the above excerpt from Engel merely teaches sending a message to a remote configuration applet using Internet Protocols. Engel does not disclose using a physical address in the context claimed by applicant, namely where the physical network address is included in the "response message containing network settings."

-4-

With respect to independent Claims 24 and 34, the Examiner has relied on the following excerpts from Engel to make a prior art showing of applicant's claimed "bootstrap module on the at least one network appliance installing the configuration package as part of an initialization bootstrap operation" (see this or similar, but not identical, language in each of the foregoing claims).

"At step 106, the remote configuration applet 20 transfers the network configuration parameters 64 to the network device 40 via the local network 50. For example, the remote configuration applet 20 may send the network communication parameters 64 via the local network 50 using a multi-cast protocol. Alternatively, the remote configuration applet 20 may send the network communication parameters 64 via the local network 50 using the TCP/IP protocol." ([0032])

The Examiner has further stated that "the settings initialize... devices that are previously unconfigured." Applicant respectfully asserts that the alleged disclosure of simply applying settings to a previously unconfigured device does not meet applicant's claim language. Specifically, applicant claims "installing the configuration package as part of an initialization bootstrap operation." Simply nowhere in Engel is there any teaching of applying configuration parameters during a bootstrap operation, such that the parameters would be applied when the device was booted up. Instead, Engel merely states that the network configuration parameters are transferred to the device (see excerpt above). Such disclosure clearly does not include any sort of bootstrap operation in the context claimed by applicant.

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. This criterion has simply not been met by the Engel reference, as noted above.

-5-

In addition, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. Thus, notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P372/01.085.02).

Respectfully submitted,
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